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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ANDERSON, REBECCA L

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 10/22/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/961,347

Applicant(s)

JANIN ET AL.

Examiner

Rebecca L Anderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) 24,25 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-23,27,28,30-32 and 40 is/are rejected.
- 7) ☒ Claim(s) 26 and 33-39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/608519.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION***Election/Restrictions***

Applicant's election with traverse of Group I, claims 21-28 and 30-40 in Paper No. 8 and the election of the species of Example 2 of the specification in Paper No. 10 are acknowledged. It is noted that claim 40 was amended in Paper No. 8 to correct a typographical error and therefore the restriction requirement of claim 40 is withdrawn and claim 40 is rejoined with the Group I, claims 21-28 and 30-39. The traversal is on the ground(s) that the search required for Group II would be substantially co-extensive with Group I, and, therefore, a restriction requirement should not be made unless there is a serious burden on the Examiner to examine all of the claims in a single application. This is not found persuasive because the inventions are independent and distinct because there is no patentable co-action between the groups and a reference anticipating one member will not render another obvious. Each group is directed to art recognized divergent subject matter which require different searching strategies for each group. Moreover, the examiner must perform a commercial database search on the subject matter of each group in addition to a paper search, which is quite burdensome to the examiner.

The requirement is still deemed proper and is therefore made FINAL.

With the identification of the above noted species, the examiner, as indicated in the restriction requirement of Paper No. 7, will identify a generic concept, inclusive of said species, for examination. The generic concept is that as found in claim 21 wherein: the hydrocarbyl compound is reacted with a halogen reactant.

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The remaining subject matter of claims 21-23, 26-28 and 30-40 and the subject matter of claims 24, 25 and 29 stands withdrawn, 37 CFR 1.142 (b), as being for non-elected inventions. The withdrawn subject matter of the claims is properly restricted as said subject matter differs materially in structure and element from the elected subject matter so as to be patentably distinct, i.e. a reference which anticipated but the elected subject matter would not even render obvious the non-elected subject matter.

Additionally, the fields of search are not co-extensive.

Accordingly, the claims are drawn to more than a single invention and restriction as has been required is proper, 37 CFR 1.142 (a).

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21, 30, 31 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 4,620,040. US Patent No. 4,620,040 discloses processes for the preparation of trifluoroanisoles comprising reacting hydrogen fluoride at stoichiometric excesses of 50 and 140 percent (Examples 3 and 4, column 5, lines 5-15). As written, the claims are drawn towards any halogen containing reactant. This rejection can be overcome by deleting the term "reactant" at the end of claim 21, which would make the claims read on only halogen as the reactant and not any halogen containing reactant.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

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and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-23, 26-28, 32 and 40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1, 5, 10 and 13 of U.S. Patent No. 6316636. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims disclose a process for the synthesis of a fluorocarbon compound comprising reacting: a hydrocarbyl compound (for example, R-CFX-Y(O)r-CR'R''-Ar, claim 22, wherein Ar is a lower alkyl radical having not more than 10 carbon atoms, claim 23 ***[note: it appears claim 23 has a typographical error of "alkyl" instead of -aryl--which is supported by lines 26-28 of page 17]***) containing an sp³-hybridized halophoric carbon atom bearing at least two halogen atom substituents (for example comprising a perfluorinated carbon atom vicinal to the sulfur

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atom, claim 32), at least one halogen atom having an atomic number greater than that of fluorine and said halophoric carbon atom being bonded to at least one chalcogen (such as sulfur, claim 27, in the form of a sulfone, claim 28); with a halogen reactant (claim 21). Claim 40 discloses that the reaction can be carried out at temperatures at most equal to 100 degrees Celsius.

The claims (1, 5, 10 and 13) of US Patent No. 6316636 disclose a process for the synthesis of a fluorocarbon compound, comprising reacting a hydrocarbyl compound containing an sp³-hybridized halophoric carbon atom bearing at least two halogen atom substituents at least one halogen atom having an atomic number greater than that of fluorine (for example said halophoric carbon atom bearing three halogen atoms selected from chlorine and fluorine, claim 5) and said halophoric carbon atom being bonded to a sulfur atom (such as a sulfur atom as part of a sulfone moiety, claim 10) with a Bronstedt base wherein said Bronstedt base is a trivalent hydrocarbon derivative of elements of column VB (such as an aromatic heterocycle, claim 13) of the Periodic table complexed with a defined amount n of hydrofluoric acid (claim 1).

The difference between the claims at issue and the US Patent claims is that the claims at issue generically encompass the US Patent claims. By using the term "halogen reactant" the claims at issue encompass a Bronstedt base complexed with a defined amount of hydrofluoric acid claimed in the US Patent. Also, the specifications show the preferences of the halogen reactant and the Bronstedt base complex to be that of Example 2, the instant elected species, wherein the reagent is a pyridine-HF complex (column 14 of US Patent). The temperature for the reaction with the pyridine-

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HF complex can be seen in Table II as 100 degrees Celsius. Example 2 also shows the preference for a hydrocarbyl compound with Ar as lower aryl radical having less than 10 carbon atoms.

Therefore, although the claims are not identical, with the support of the preferences of the specification and the fact that the instant claims encompass that as claimed in the US Patent, the processes for the synthesis of a fluorocarbon compound as instantly claimed and as claimed in US Patent No. 6316636 are obvious over one another.

Claim Objections

Claims 26, 30, 31 and 33-39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 21-23, 26-28 and 30-40 are objected to as containing non-elected subject matter. The claims presented drawn solely to the elected subject matter as indicated supra, and overcoming the above mentioned rejections and objections would appear allowable.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (703) 605-1157. Mrs. Anderson can normally be reached Monday through Friday 7:00AM to 3:30PM.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone numbers are (703) 308-1235 and (703) 308-0196.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45AM to 4:45PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4242, (703) 305-3592, and (703) 305-3014.



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